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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,833	04/12/2001	Max Amon	017750-711	1959

7590 05/16/2002

Patrick C. Keane  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, VA 22313-1404

EXAMINER

AMARI, ALESSANDRO V

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 05/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/832,833

Applicant(s)

AMON ET AL. *KE*

Examiner

Alessandro V. Amari

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7 and 13-17, drawn to an Infrared lens, classified in class 359, subclass 356.
  - II. Claims 8-12, drawn to a method of forming an infrared lens, classified in class 65, subclass 66.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process of molding can be used to make a prism.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
3. During a telephone conversation with Mr. Patrick Keane on 6 May 2002 a provisional election was made with traverse to prosecute the invention of I, claims 1-7 and 13-17. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 8-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7 and 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Chipper, U.S. Patent 6,018,414.

In regard to claim 1, Chipper discloses (see Figures 2A and 2B) an IR lens comprising: a first surface (left side of 32); and a second surface (right side of 32), wherein the IR lens is a moldable IR transmissive material as described in column 5, lines 63-67 and column 7, lines 28-29 and at least one surface is an optically significant surface as shown in Figures 2A and 2B. Since the specification defines an optically significant surface as a flat, spherical, aspherical or kinoform surface, the reference meets the claimed limitation.

Regarding claim 2, Chipper discloses that the optically significant surface comprises a surface relief holographic grating as described in column 9, lines 40-47.

Regarding claim 3, wherein the optically significant surface is formed directly in a molding operation, it should be noted that if a product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. [*In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966].

Regarding claim 4, Chipper discloses that the moldable IR transmissive material is a chalcogenide glass as described in column 6, lines 12-16.

Regarding claim 5, Chipper discloses that the moldable IR transmissive material is an arsenic selenide glass as described in column 6, lines 12-16.

Regarding claim 6, wherein the lens is manufactured as a unitary structure in a molding operation, it should be noted that if a product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. [*In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966].

In regard to claim 7, Chipper discloses (see Figures 2A and 2B) an IR lens comprising: a first surface (left side of 32); and a second surface (right side of 32), wherein the IR lens is made from a moldable IR transmissive material as described in column 5, lines 63-67 and column 7, lines 28-29 and wherein at least the second surface is an optically significant surface molded from the moldable IR transmissive material as described in column 5, lines 63-67 and column 7, lines 28-29. Since the

specification defines an optically significant surface as a flat, spherical, aspherical or kinoform surface, the reference meets the claimed limitation.

In regard to claim 13, Chipper discloses (see Figures 2A and 2B) an IR lens comprising: a first spherical surface (32); and a second nonspherical surface (42), as described in column 6, lines 52-55, wherein the second nonspherical surface comprises a surface relief holographic grating as described in column 9, lines 40-47, wherein the lens is made from a moldable IR transmissive material as described in column 5, lines 63-67 and column 7, lines 28-29.

Regarding claim 14, Chipper discloses that the moldable IR transmissive material is a chalcogenide glass as described in column 6, lines 12-16.

In regard to claim 15, Chipper discloses (see Figures 2A and 2B) an infrared imaging optical arrangement comprising: a first lens (32); and a second lens (38), wherein at least the first lens is made from a moldable IR transmissive material as described in column 5, lines 63-67 and column 7, lines 28-29 and wherein at least the first lens has at least one optically significant surface as shown in Figures 2A and 2B. Since the specification defines an optically significant surface as a flat, spherical, aspherical or kinoform surface, the reference meets the claimed limitation.

Regarding claim 16, Chipper discloses that the optically significant surface comprises a surface relief holographic grating as described in column 9, lines 40-47.

Regarding claim 17, Chipper discloses that the moldable IR transmissive material is a chalcogenide glass as described in column 6, lines 12-16.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (703) 306-0533. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

ava *ava*  
May 14, 2002



**Cassandra Spyrou**  
**Supervisory Patent Examiner**  
**Technology Center 2800**